

## REMARKS

Applicant respectfully requests reconsideration of this application in light of the remarks made herein.

Claims 1 and 56-58 stand rejected under § 103(a) as being obvious over U.S. Patent No. 5,818,723 to Dimitri (hereinafter referred to as "Dimitri") in view of U.S. Patent No. 5,442,500 to Hidano et al. (hereinafter referred to as "Hidano"). Claims 7-11 are objected to as being dependent upon a rejected base claim, but are recognized as containing allowable subject matter.

Applicant respectfully requests that the U.S. Patent and Trademark Office (hereinafter referred to as the "Office") allow the above case based on the arguments presented below or make any rejections final so that Applicant may pursue review of the examination through Appeal.

### **Rejections Under 35 U.S.C. § 103**

Claims 1, 56, 57 and 58 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Dimitri in view of Hidano.

As an initial matter, Applicant points out that in the four responses previously made (3/14/2006, 8/29/2006, 10/11/2006 and 6/01/2006), the Office has never responded to the merits of Applicant's arguments, rather, the Office has simply inserted the *cut and paste* response "Applicant's arguments with respect to claims have been considered but are moot in view of the new grounds(s) of rejection." Two of the rejections (7/12/2006 and 9/11/2006) were directed to Hidano in view of Dimitri. The Pre-Appeal Brief Request for Review Conference Decision of 12/06/2006 withdrew the rejection of Hidano in view of Dimitri and reopened prosecution. The Office Rejection of 3/02/2006 removed Dimitri as a prior art reference and combined Hidano with Matsushima (US 6,424,603). Now, Matsushima is removed as a prior art reference, and a new Non-Final Rejection has been issued with Dimitri in view of Hidano. Applicant believes that they are entitled to at least a response addressing in detail previous arguments that Hidano and

Dimitri do not show all the features as recited in claims 1, 56-58 and that one skilled in the art would not have been motivated to combine the references.

The Office asserts that Dimitri shows a shelf system, magazines, drives, a cartridge and magazine transport that moves cartridges and magazines within the library. The Office admits, "Dimitri does not show a cabinet and an entry/exit port for conveying one of the data cartridge magazines between an environment that is exterior to the cabinet and the interior space; wherein the interior space is accessible to the magazine transport device so that the magazine transport device can move one of the data cartridge magazines between the interior space and the shelf of the shelf system."

The Office asserts that Hidano makes up for Dimitri's deficiencies because "Hidano et al shows a magazine based library, which has a cabinet for accommodating all the elements, and an entry/exit port 51 (Fig. 1, column 4, lines 46-50) for conveying one of the data cartridge magazines between an environment that is exterior to the cabinet and the interior space." Aspects of this assertion are incorrect, such as Hidano's showing a cabinet with "all of the elements" because, based on the Office's earlier admissions, certain *elements* in Hidano which were made of record are disparate from the claimed elements, hence the Office's reliance of Dimitri in an attempt to satisfy the deficiencies of Hidano (see the Office Action, 7/12/2006, pg. 3). For example, Hidano's drawer 52 is hardly equivalent to Dimitri's magazine transport assembly 110.

The Office's motivation to combine Dimitri with Hidano is as follows: "It would have been obvious at the time the invention was made that one of ordinary skill in the art would apply the cabinet taught by Hidano et al onto Dimitri's device. The rationale is as follows: Dimitri discloses a library, which has to be accommodated in some way but Dimitri does not specify it. Hidano et al shows a library, which is accommodated in a cabinet; and accommodating a library in a cabinet is a common practice in the art. One of ordinary skill in the art would have been expecting that Dimitri's library should have also been accommodated in a cabinet. Hidano et al further shows that there is a magazine entry/exit port formed on the cabinet and reaches that it allows the magazine to be inserted and removed from the cabinet (Figs. 1 and 2; column 7, lines 40-55). One of

ordinary skill in the art would have been motivated to include the entry/exit port on the cabinet for being able to exchanging the magazine with outside.” [SIC]. The Office further elaborates that “Since in Dimitri’s device the magazine transporting device can access all the magazines, thus in the combined device, the interior space accommodates a magazine, therefore, is accessible to the magazine transport device so that the magazine transport device so that the magazine transport device can move one of the data cartridge magazines between the interior space and the shelf of the shelf system.” [SIC].

Though Hidano does indeed disclose a magazine, the magazine and its construction is inapposite to the magazine that is used in Dimitri, and hence is not combinable. Hidano’s magazine 30 serves the purpose of performing the function of an additional rack 2a, see FIG. 5, that is not intended to be moved within the storage system. Once loaded from the outside, the cartridges in the magazines 30 are positioned to be flush and aligned with the cartridges disposed in the racks 2a, thus functioning as exchange racks. The magazines are retained in the rack body 52 of the racks 2b by rod member 62 (FIG. 11) which serves to both retain the magazine and unlock the cartridges to be moved within the library. Furthermore, assuming, *arguendo*, that Hidano’s magazines were not simply exchange racks that are locked in place but were somehow intended to be moved around a library, such a magazine would not function with Dimitri because Dimitri teaches a magazine with two open sides in order to be accessed from either side of Dimitri’s shelf via Dimitri’s two magazine transports in order to function as a high speed library. Thus, such a proposed modification would result in an unreasonable expectation of success because such a combination is inconsistent with the intentions of both Dimitri and Hidano. When the references are combined, there must be a reasonable expectation of success in order for the proposed combination to be obvious. *In re Vaeck*, 947 F. 2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Even in light of the Supreme Court’s opinion in *KSR vs. Teleflex*, one of ordinary skill in the relevant field would not have been motivated to combine a high speed, quick access magazine library like that of Dimitri with Hidano’s large, expandable, high capacity cassette library, which is intended to move only single tape cassettes within the

library. Such a combination is incompatible with and in contradiction to the teachings, goals and intentions of each of the references and will not yield an operating system. For example, the Office's entrenched approach that Hidano provides a library that uses a magazine, a drawer, a magazine entry port, a drive and a cartridge transport ignores these components' respective interrelationship and therefore the functionality, spirit and intention of Hidano. Furthermore, even though the Supreme Court rejected a "rigid" application of the "teaching, suggestion, or motivation" (TSM) test, there is justifiable cause for application of the TSM test here because, in the absence of any objective teaching in the prior art that would lead an individual to combine the relevant teachings of the references, one skilled in the art would not have been motivated to combine any references that would lead to the creation of a contorted and dysfunctional apparatus dislike that of Applicant's claimed invention.

Additionally, the Office asserts the motivation to combine Dimitri and Hidano may lie in the need to use Hidano's cabinet for Dimitri and thus use Hidano's exchange drawer 52 to move magazines into Dimitri, in quotes as proposed on page 3 of the Office Action, "One of ordinary skill in the art would have been motivated to include the entry/exit port on the cabinet for being able to exchanging the magazine with outside." Such a passage ignores that Hidano is not exchanging magazines between the inside and outside via Hidano's opening 51 and, therefore, a simple substitution does not yield and expectation of success.

The Office has engaged in the improper act of attempting hindsight reconstruction of the claimed invention by finding bits and pieces of the claim elements in prior art references, and ignoring whether, at the time of the Applicant's claimed invention, one of ordinary skill would deem it obvious to combine the bits and pieces in the manner proposed. Nothing in KSR modified the long-standing prohibition against such hindsight reconstruction in an attempt to deny patentability. Accordingly, Dimitri in view of Hidano cannot sustain a Section 103 rejection because (1) the proposed combination of Dimitri and Hidano fails to provide true correspondence of all of the recited elements of claim 1 and (2) one of ordinary skill in the art would find it unobvious to combine the

teachings of the prior art that are designed to achieve mutually incompatible purposes. Hence, reconsideration and withdrawal of the present rejection of claim 1 are respectfully requested.

Independent claim 56 is rejected under 35 U.S.C. §103(a) as being unpatentable over Dimitri in view of Hidano.

The Examiner asserts that Dimitri in view of Hidano includes all of the recited elements of claim 56, however, as previously pointed out, this assertion is incorrect. Nowhere does Dimitri nor Hidano teach or suggest a common transport moving a magazine from an entry exit port to spaces around a library, as featured in claim 56. Superimposing Hidano's opening 51 and drawer system 52 with Dimitri's library does not yield Applicant's claimed invention, as discussed above. Such a combination of references does not meet at least a reasonable expectation of success required by the Office to make a convincing prima facie case of obviousness. For at least the reasons, Applicant respectfully submits claim 56 is allowable over the prior art of record.

Claim 57 depends directly from claim 56 and, as discussed above, is distinguishable over Dimitri in view of Hidano because neither Dimitri nor Hidano disclose, teach or suggest all of the recited features of claim 56 from which claim 57 depends. Therefore, Applicant respectfully submits that claim 57 is allowable.

Independent claim 58 is rejected under 35 U.S.C. §103(a) as being unpatentable over Dimitri in view of Hidano. Claim 58 recites, "an entry/exit port capable of receiving one of said magazines into said interior space from outside said interior space wherein said magazine is movable within said interior space; and a magazine transport device, confined to said interior space and adapted to move one of said magazines received by said entry/exit port within said interior space either to said shelf system or to a location in proximity to said drive..." As previously discussed, Hidano's opening 51 and drawer system 52 are incapable of being used as an entry/exit port as recited in claim 58. Therefore, for at least the reason that the references, Dimitri and Hidano, are devoid

of certain purportedly corresponding elements, Applicant respectfully submits claim 58 is allowable over the prior art of record.

### **Claim Objections**

According to the Office Action, claims 7-11 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Dependent claims 7-11 depend directly or indirectly from independent claim 1 which, as discussed above, is patentable over Dimitri in view of Hidano, and therefore Applicant submits claims 7-11 are allowable as being dependent from allowable claim 1.

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Authorization To Charge Necessary Fees

The Commissioner is hereby authorized to charge any additional necessary fees associated with this submission, or credit any overpayment, to Deposit Account No. 50-3010.

Respectfully submitted,

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Kenneth Altshuler  
Reg. No. 50,551

Correspondence Address

HISCOCK & BARCLAY, LLP  
200 HSBC Plaza  
100 Chestnut Street  
Rochester, New York 14604-2404  
Telephone: (303) 449-6444 x1251  
Telephone: (585) 295-4497  
Facsimile: (585) 295-8453

Customer No.: 67,070

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